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Remarks

In the instant application, claims 1-13 are pending. Reconsideration of this application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim Rejections under 35 U.S.C. § 112

Claims 3, 4, 11, and 13 stand rejected under 35 U.S.C. § 112 as being indefinite. Claims 3, 4, and 11 have been amended to correct the dependencies as set forth in the Office Action. Further, claim 13 has been amended to correct the dependency and to address the step for the process as claimed. As such, claims 3, 4, 11, and 13 are now definite. Withdrawal of the rejections of these claims is respectfully requested.

Claim Rejection under 35 U.S.C. § 102

Claims 1-4 and 9-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,801,283 to Laue et al. Laue discloses enantiomerically pure bisphosphines as well as their use in metal complexes as catalysts for asymmetric reactions. *See Laue, column 1, lines 5-7.* The compounds disclosed in Laue, however, are not bridged in the 6, 6' – position of the biphenyl ligand. The biphenyl group according to Laue is substituted in the 6, 6' – position by a methoxy group(s). *See formul (V) of Laue.* The compounds of the present claims, on the other hand, feature a biphenyl ligand bridged at the 6, 6' – position with a –O-B-O– moiety (both formula (I) and formula (IV)).

In view of the foregoing, Laue does not disclose compounds according to the instant claims. As such, Laue does not anticipate claim 1. Withdrawal of the rejection is respectfully requested.

Claims 2-4 depend either directly or indirectly from claim 1 and are patentable over the cited reference for at least the same reasons as set forth for claim 1. Withdrawal of the rejection of these claims is respectfully requested.

Claim 9 recites compounds of formula (IV), which, as stated above, are not disclosed by Laue. Therefore, claim 9 is patentable over Laue. Withdrawal of the rejection is respectfully requested.

Claims 9-12 depend either directly or indirectly from claim 9 and are patentable over the cited reference for at least the same reasons as set forth for claim 9. Withdrawal of the rejection of these claims is respectfully requested.

#### Claim Rejection under 35 U.S.C. § 103

Claims 1-4 and 9-12 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 6,583,312 to Sirges et al. in view of JP 3146187 to Yokozawa et al.

Sirges disclosed processes for preparing optically active trimethylactic acid and/or esters thereof by catalytic hydrogenation of trimethylpyruvic acid and/or esters thereof. *See Sirges: Abstract*. Further, the process of Sirges utilizes a catalyst of metal complexes containing optically active bisphosphines as ligands. *See Sirges column 2, lines 36-38*. Further, the catalysts presented in Sirges include a bisphosphine, listed as general formula (B3). *See Sirges, column 3, lines 40-66*. In contrast to the bisphosphines of Sirges stand the compounds according to claim 1 (formula (I)) and/or 9 (formula (IV)) of the present invention. The instant compounds include a bridged moiety at the 6, 6' – position. Sirges does not disclose a bisphosphine having a biaryl ligand having this bridged moiety. In fact, the compound of Sirges at the R<sub>6</sub> position recites methyl, methoxy, or trifluoromethyl. *See Sirges, column 3, line 66*. Therefore, Sirges does not teach or suggest compounds having the bridged moiety as set forth in the instant claims.

Moreover, the Yokozawa reference does not teach or suggest bisphosphine compounds having a bridged moiety at the 6, 6' – position. The compounds of Yokozawa feature a methoxy moiety at these positions, which does not allow for a bridging at this position. Yokozawa combined with Sirges does not feature a bisphosphine having this bridged moiety. As such, the combination of Sirges with Yokozawa does not remotely teach or suggest to one

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skilled in the art the compounds featured in the instant claims. Therefore, Siges and Yokozawa either alone or in combination do not render the instant claims obvious. Withdrawal of the rejection is respectfully requested.

Claims 2-4 depend either directly or indirectly from either claim 1 or claim 9 and are patentable over the cited reference for at least the same reasons as set forth for claim 1 or claim 9. Withdrawal of the rejection of these claims is respectfully requested.

Rejection under Double Patenting

Claims 1-13 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of co-pending Application Serial No. 11/298,641. An Express Abandonment was filed on the same day as this Amendment expressly abandoning the '641 application. A copy of the Express Abandonment is attached for the convenience of the Examiner. With the filing of the Express Abandonment, the double patenting rejection is now rendered moot. Withdrawal of such is respectfully requested.

In view of the forgoing, claims 1-13 are now in condition for allowance. A prompt response to this Amendment in the form of a Notice of Allowability is hereby solicited.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 C.F.R. 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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